

REMARKS

Claims 1-9 are pending in this application. By this Amendment, claims 1-3 are amended. No new matter is added. Reconsideration of the application based on the foregoing amendments and following remarks is respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representatives by Examiner Shosho in the September 25 personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

The Office Action rejects claims 1-9 under the written description requirement of 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses the rejection.

The Office Action asserts that the phrases "a first dispersing agent that is different from the first resin particles" and "a second dispersing agent that is different from the second resin particles," in claim 1, are not supported by the specification. While Applicant does not agree with this assertion, Applicant voluntarily amends claim 1 to obviate the rejection.

Applicant's representative presented the above claims amendments to Examiner Shosho during the September 25 personal interview. The Examiner indicated that these claim amendments appeared to overcome the rejection of the pending claims under 35 U.S.C. §112, first paragraph.

For the foregoing reasons, claims 1-9 are amply supported by the instant specification. Accordingly, reconsideration and withdrawal of the rejection of claims 1-9 under 35 U.S.C. §112, first paragraph as failing to meet the written description requirement, are respectfully requested.

The Office Action rejects claims 1-9 under 35 U.S.C. §112, second paragraph as being indefinite. Applicant respectfully traverses the rejection.

The Office Action asserts that the claims are indefinite for reciting "first" and

"second" to describe various components of the recited black and color inks. The use of the terms "first" and "second" a commonly used technique for differentiating between multiple, similarly-named components in a single claim or series of related claims. The use of the words "first" and "second" does not infer that the first and second components are necessarily the same or necessarily different, but merely allows for convenient reference to multiple, similarly-named components throughout the claims. Applicant submits that the use of the words "first" and "second" in the instant claims exemplifies a clear and commonly used claim drafting technique (*see, e.g.*, U.S. Patent No. 6,540,329 to Ma et al. cited in the Office Action). As such, use of the terms "first" and "second" do not render the subject matter of the pending claims indefinite.

During the September 25 personal interview, Examiner Shosho agreed that the use of the terms "first" and "second" in describing the components of each of the black ink and color ink clarify the claims, do not render the claims indefinite, and are, therefore, acceptable.

The Office Action further rejects claims 1-9 under 35 U.S.C. §112, second paragraph, for being indefinite by reciting the "first pH" and "second pH." Although Applicant believes the claim language is clear as drafted, Applicant voluntarily amends claims 1-3 to change "first pH" to "pH of the black ink" and "second pH" to "pH of the color ink," in each case solely for clarity.

For the foregoing reasons, claims 1-9 are definite. Accordingly, reconsideration and withdrawal of the rejection of claim 9 under 35 U.S.C. §112, second paragraph, as being indefinite, are respectfully requested.

The Office Action rejects claims 1-3 and 5-9 under 35 U.S.C. §103(a) over U.S. Patent No. 6,540,329 to Ma et al. ("Ma") in view of U.S. Patent No. 6,670,409 to Yatake ("Yatake"). Applicant respectfully traverses the rejection.

Claim 1 recites "[a] color ink set comprising a black ink and a color ink that is

different from the black ink, wherein: the black ink comprises ... first resin particles having carboxyl groups ... a first dispersing agent ... the color ink comprises ... second resin particles ... a second dispersing agent ..." (emphasis added). Ma and Yatake do not teach or suggest such an ink set.

The Office Action asserts that Ma discloses an ink set comprising a black ink including a resin having a carboxyl group, and a color ink including resin obtained from sulfopropyl acrylate. The Office Action concedes that the inks of Ma do not include a separate dispersing agent, but asserts that Yatake suggests employing a dispersant such as a styrene-acrylic resin in the inks of Ma. This conclusion is incorrect.

The Office Action correctly points out that (a) the inks of Ma include resins (*see, e.g.*, column 4, lines 21 to 30), and (b) the inks of Yatake include dispersants (*see, e.g.*, column 6, lines 64 to 67; column 7, lines 40 to 48). However, there is no suggestion in either of the references to employ the dispersants of Yatake in the inks of Ma. The polymers in the inks of Ma are disclosed to be dispersants (*see* column 7, lines 36 to 40). Although the Office Action asserts that resin may be present in the ink of Ma in the form of a dispersant or added independently of the colorant (*see* page 7, first paragraph of the Office Action), Ma, in col. 7, lines 36-38, only discloses a method for introducing the polymer into the ink, and does not teach or suggest that a polymer can be present in addition to a dispersant. That is, the inks of Ma already include dispersants in the form of polymers, before being modified to include the dispersants of Yatake, as proposed in the Office Action. One of ordinary skill in the art would not be motivated to add a dispersant to an ink that already includes a dispersant, absent some explicit suggestion to do so. Neither of the references teaches or suggests that a combination of the polymers disclosed in Ma and the dispersants disclosed in Yatake would in any way improve the performance of an ink. Ma clearly discloses the presence of polymers as dispersants and asserts no shortfall regarding such presence. For at least this reason, the

Office Action fails in its attempt to demonstrate that one of ordinary skill in the art would have been motivated to combine the teachings of Ma and Yatake, thereby failing to make a *prima facie* case of obviousness.

Applicant's representatives presented the above argument regarding the combinability of Ma and Yatake to Examiner Shosho during the September 25 personal interview. Applicant appreciates the indication in the personal interview from Examiner Shosho that she understood and agreed with the above arguments. Specifically, the Examiner indicated that she agreed that, based on the arguments that Applicant's representatives presented during the personal interview, Ma and Yatake were not combinable in the manner suggested by the Office Action to render obvious the subject matter of the pending claims.

For at least this reason, any permissible combination of Ma and Yatake cannot reasonably be considered to teach, or to have suggested, the combination of all the features positively recited in independent claim 1. Further, claims 2, 3 and 5-9 would also not have been taught nor would they have been suggested by this combination of applied prior art references, for at least their respective dependencies claimed directly or indirectly on allowable independent claim 1, as well as for the simply patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-3 and 5-9 under 35 U.S.C. §103(a) as being unpatentable over Ma in view of Yatake are respectfully requested.

The Office Action rejects claim 4 under 35 U.S.C. §103(a) over Ma in view of Yatake and U.S. Patent No. 6,136,890 to Carlson et al. ("Carlson"). Applicant respectfully traverses the rejection.

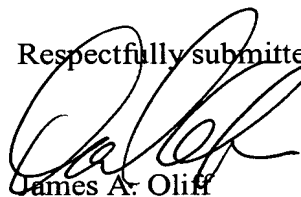
Ma and Yatake do not suggest the ink set of claim 1 for at least the reasons set forth above. Carlson does not remedy the deficiencies in the application of Ma and Yatake to the

subject matter of claim 1 which claim 4 depends. Carlson is cited for its alleged teaching of the use of polyurethane resins including carboxyl groups. However, Carlson, like Ma and Yatake, fails to suggest an ink set including a black ink and a color ink, each of the inks including both resin particles and a separate dispersing agent. As neither Ma, Yatake, nor Carlson suggests such an ink set, with the combination of features positively recited in claim 1, this combination of references fails to render obvious the subject matter of claim 7. Claim 4 depends from claim 1 and, thus, also would not have been rendered obvious by Ma, Yatake and Carlson. Accordingly, reconsideration and withdrawal of the rejection of claim 4 under 35 U.S.C. §103(a) as being unpatentable over this combination of applied references are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-9 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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